

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

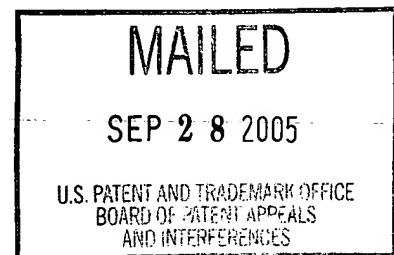
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DAVID J. MATZ and
MANOHARAN S. VELLALAPALAYAM

Appeal No. 2005-1015
Application No. 09/342,765

ON BRIEF



Before JERRY SMITH, DIXON, and BARRY, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-31,
which are all of the claims pending in this application.

We **AFFIRM**.

BACKGROUND

Appellants' invention relates to a portable user interface for presentation of information associated with audio/video data. An understanding of the invention can be derived from a reading of exemplary claims 1 and 20, which are reproduced below.

1. A system comprising:
 - a source containing multimedia data;
 - a browser having a user interface to display a presentation of the multimedia data; and
 - a markup language file associated with a script handler and loadable by the browser, the script handler executable to process multimedia data received from the source for presentation to the browser user interface.
20. An article including one or more machine-readable storage media storing instructions for presenting audio/video data, the instructions when executed causing a system to:
 - generate an interface in a browser, wherein the interface is created by a scripted markup language file;
 - receive multimedia data from a source;
 - display information associated with the multimedia data in the interface of the browser; and
 - present the multimedia data in the browser.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Judson

5,572,643

Nov. 5, 1996

Appeal No. 2005-1015
Application No. 09/342,765

Peyer	6,188,401	Feb. 13, 2001 (Filed Mar. 25, 1998)
Lindblad et al. (Lindblad)	6,225,993	May 1, 2001 (Filed Apr. 22, 1996)

Claim 20 stands rejected under 35 U.S.C. § 102 as being anticipated by Peyer. Claims 1-3, 5-7, 9-14, 16-19 and 21-31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Judson and Peyer. Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Judson and Peyer. Claims 8, 15, and 28 stand rejected under 35 U.S.C. § 103 over as being unpatentable over Judson and Peyer and Lindblad.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the answer (mailed May 19, 2004) for the examiner's reasoning in support of the rejections, and to the brief (filed Mar. 03, 2004) and reply brief (filed Jul. 21, 2004) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We find that appellants' brief is DEFECTIVE since it does not comply with 37 CFR 1.192(c)(5) which requires appellants to set forth a "CONCISE" explanation of the subject matter defined in the claims. (see 37 CFR § 41.37(c)(1)(v) effective September 13, 2004 replacing 37 CFR § 1.192(a).) We find that pages 2-14 of the brief is not a good faith effort to set forth a summary of the invention and amounts to a restatement of the entire specification. Rather than issue a Notice of Non-Compliance, we will accept the brief in its present condition and issue a decision on the merits.

Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), **cert. denied**, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in **Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983),

cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it." While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. **See Studiengesellschaft Kohle v. Dart Indus., Inc.**, 726 F.2d 724, 726-727, 220 USPQ 841, 842-843 (Fed. Cir. 1984).

Initially, we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. **See Verdegaal Bros. Inc. v. Union Oil Co.**, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), **cert. denied**, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (**see Hazani v. Int'l Trade Comm'n**, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and **RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (**see Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984)).

The examiner maintains that Peyer teaches the claimed invention and provides a basic correlation of the claim limitations to the teachings of Peyer. (Answer at page 3.) Appellants argue that Peyer does not teach the claimed invention since Peyer does not teach instructions to cause a system to generate an interface in a browser (where the interface is created by a scripted markup language file) and present multimedia data in the browser. Appellants argue that Peyer clearly teaches a browser instance to display multimedia presentation and another browser instance that provides a user interface. (Brief at page 23.) Here, we note that appellants argue the limitation of “a browser” in the claim language and plural “browser instances” in the teachings of Peyer. From our understanding of the teachings of Peyer, we find that both the first and second browser instances are from the same browser in MICROSOFT’s browser. These would be two instantiations of the same browser since one is taught to run on top of the other so as to perform a customization without having to modify the base browser. (Peyer at columns 1 and 2.) Peyer discloses at column 5, lines 66- column 6, line 1, that Application 74 includes a browser program 104 that is actually one or more instances of the Microsoft Web Browser ActiveX control. Peyer further discloses that user interfaces are in a separate browser instance and the television or video content are viewed in their own browser instance. Figure 4 of Peyer discloses that the three primary components are implemented in separate browser instances: user interface 150, internet content 152 and live television content 154.

From our review of the teachings of Peyer, we find that Peyer teaches the use of the same browser which reads on the broad recitation in independent claim 20. Therefore, we agree with the examiner's interpretation of the claim language and application of the prior art. Therefore, we find that the examiner has established a ***prima facie*** case of anticipation of independent claim 20 which has not been adequately rebutted by appellants, and we will sustain the rejection of independent claim 20.

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See *In re Rijckaert***, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A ***prima facie*** case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See *In re Lintner***, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is ***prima facie*** obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See *In re Fine***, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must

rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), **citing In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999-1000, 50

USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 1. The examiner maintains in this rejection that Judson teaches all of the limitation of independent claim 1, but for that the browser of Judson, which has a user interface and a script handler, fails to explicitly teach that the script handler can process multimedia data received from the source of the presentation. (Answer at page 4.) From our review of the teachings of Judson, we find that the information supplied to the user during the period between link activation and downloading of the hypertext document need not be merely a visual output and is envisioned that some or all parts of a particular message be conveyed to the user aurally via a multimedia speaker set as well as on the display screen. (Judson at column 6, lines 30-35.) We find this teaching to be a clear suggestion that the user interface would encompass multimedia in its presentation and script handling. With that said, we than agree with the examiner reliance upon the teachings of Peyer with respect to the script handling of multimedia and motivation for combining the teachings.

Appellants argue that neither Judson or Peyer teach or suggest the markup language file of independent claim 1 and that the file is associated with a script handler

and is loadable by a browser where the script handler is executable to process multimedia data received from a source for presentation to a browser user interface. (Brief at page 17.) Appellants argue that Peyer teaches away from such an arrangement in that Peyer teaches separate browser instances for each of these functions. As discussed above, we do not find this argument persuasive since we find a distinction between the browser and browser instances where the same browser is used in each of the browser instances. Therefore, this argument is not persuasive. Appellants argue that the teaching away of Peyer negates any suggestion or motivation for the combination. (Brief at pages 17-18 and reply brief at pages 2-3.) We disagree and do not find that Peyer teaches away from the combination. Therefore, this argument is not persuasive, and we sustain the rejection of independent claim 1 and dependent claims 2-9 which appellants elected to group therewith.

With respect to independent claim 10, we find appellants reiterate the claim language, state that neither reference teaches or suggests the claimed limitations and reiterates the arguments with respect to the plural browser instances in Peyer and that this teaches away from the combination. (Brief at pages 19-20.) We find this argument unpersuasive as discussed above, and we sustain the rejection of independent claim 10 and dependent claim 11 which appellants elected to group therewith.

With respect to independent claim 12, we find appellants reiterate the claim language, state that neither reference teaches or suggests the claimed limitations and

reiterates the arguments with respect to the plural browser instances in Peyer and that this teaches away from the combination. (Brief at pages 20-21.) We find this argument unpersuasive as discussed above, and we sustain the rejection of independent claim 12 and dependent claims 13-15 which appellants elected to group therewith.

With respect to independent claim 16, we find appellants reiterate the claim language, state that neither reference teaches or suggests the claimed limitations and reiterates the arguments with respect to the plural browser instances in Peyer and that this teaches away from the combination. (Brief at pages 22-23.) We find this argument unpersuasive as discussed above, and we sustain the rejection of independent claim 16 and dependent claims 17-19 which appellants elected to group therewith.

With respect to independent claim 21, we find appellants reiterate the claim language, state that neither reference teaches or suggests the claimed limitations and reiterates the arguments with respect to the plural browser instances in Peyer and that this teaches away from the combination. (Brief at pages 24-25.) We find this argument unpersuasive as discussed above, and we sustain the rejection of independent claim 21 and dependent claims 22-29 which appellants elected to group therewith.

With respect to independent claim 30, we find appellants reiterate the claim language, state that neither reference teaches or suggests the claimed limitations and reiterates the arguments with respect to the plural browser instances in Peyer and that this teaches away from the combination. (Brief at pages 25-26.) We find this argument

Appeal No. 2005-1015
Application No. 09/342,765


unpersuasive as discussed above, and we sustain the rejection of independent claim 30 and dependent claim 31 which appellants elected to group therewith.

CONCLUSION

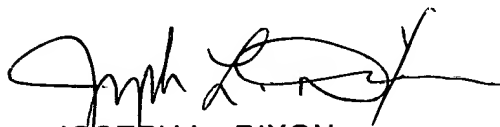
To summarize, the decision of the examiner to reject claims 1-31 under 35 U.S.C. § 103 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED



JERRY SMITH
Administrative Patent Judge



JOSEPH L. DIXON
Administrative Patent Judge



LANCE LEONARD BARRY
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)

JD/rwk

Appeal No. 2005-1015
Application No. 09/342,765

TIMOTHY N. TROP
TROP PRUNER HU & MILES PC
8554 KATY FREEWAY STE 100
HOUSTON, TX 77024